



1076.41037TRN
NC 33733 US
07 39518

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Richard HATCH
Serial No.: 10/023,699
Filed: December 21, 2001
For: MOBILE NETWORK MESSAGE TO EMAIL REDIRECTION
Art Unit: 2681
Examiner: Sheila B. Smith

DECLARATION PURSUANT TO 37 C.F.R. §1.131

Commissioner for Patents

P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

I, Dhiren Patel, hereby declare as follows in support of proving evidence of conception followed by due diligence leading to a constructive reduction to practice of the present application on December 21, 2001 which extends from a time period before the July 19, 2001 priority date of U.S. Patent Publication 2003/0016639, which has been cited in the rejection of claims 1-12 under 35 U.S.C. §102.

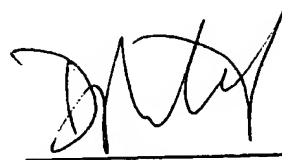
I am intellectual property counsel employed by the Assignee, Nokia Corporation. I have first-hand knowledge that the documentation cited herein in my Declaration was prepared in the ordinary course of business of the Assignee, Nokia Corporation, in filing the above-referenced patent application in the United States.

The sequence of events about which I have first hand knowledge is as follows:

- (1) Submission of Invention Report signed by the inventor, Richard HATCH, and dated 10 July 2001 to Nokia Intellectual Property Rights Department.
- (2) A July 24, 2001 Memo from the Nokia Intellectual Property Rights Department to the inventor confirming that the Invention Report has been received;
- (3) An August 1, 2001 Memo from the Nokia IPR Department to the inventor advising that the invention has been accepted for filing;
- (4) An August 1, 2001 Memo from the Nokia IPR Department to the Nokia Human Relations Department asking the obtainment of a Stage 1 award to the inventors for acceptance of the invention be made;
- (5) An October 2001 letter from the Nokia IPR Department to outside counsel, Venner Shipley & Co., requesting drafting and filing of a patent application in the United States along with a sheet containing a summary of the invention;
- (6) A December 13, 2001 letter from the Nokia IPR Department to Venner Shipley & Co. acknowledging receipt of the draft patent application along with notes relating to pages of the specification;
- (7) A December 19, 2001 letter from the Nokia IPR Department to Venner Shipley & Co. acknowledging receipt of the revised draft patent application along with notes relating to pages of the specification; and
- (8) A December 24, 2001 letter from Venner Shipley & Co. confirming the application was filed in the United States Patent and Trademark Office.

I declare under the penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

Date: January 10, 2005

A handwritten signature in black ink, appearing to read 'Dhiren Patel', written over a horizontal line.

Dhiren Patel

NOKIA

JH x d 21.08.01

MEMORANDUM

To: Richard Hatch **From:** Dhiren Patel
Date: 1st August 2001 **Direct Line:** +44 (0) 1252865285
Subject: Patent Committee decision
NC 33733
Title: SMS/EMAIL REDIRECTION SERVICE

At the Patent Committee held on 1st August 2001 the above invention report was accepted for filing and given a rating of 3.

The patent attorney responsible will contact you in due course about this matter. In the meantime, it would be helpful if you could send me any further information about the invention.

Regards



Dhiren Patel

DP/PT/001p

Nokia IPR Department
Nokia House
Summit Avenue
Farnborough
Hampshire
GU14 ONG



MEMORANDUM

UK IPR DEPARTMENT

To: Richard Hatch **From:** Lorraine McLoughlin
Date: 24 July 2001 **Direct Line:** +44 (0) 1252 867242
Subject: New Patent Proposal
Ref: SMS / EMail Redirection Service
"NC 33733"

Thank you for submitting the Invention Report which has been allocated the reference number shown above.

The assigned Patent Attorney is Dhiren Patel.

The Invention Report will be assessed and you will be informed in due course whether or not we intend to seek patent protection. Your cooperation will then be required in the preparation of the patent application.

If the invention is just an idea at the moment, please take care to notify the Patent Department when the invention is actually implemented and supply any supporting documentation.

Please note that until the patent application has actually been filed (when you will be informed), the subject matter of your Invention Report must be kept entirely confidential. Any disclosure to third parties in any way, e.g. even by spoken description or demonstration, could invalidate any patent we may obtain.

Therefore, if there is any risk that the subject matter might enter the public domain, e.g. if it is due to be included in production, please let Dhiren Patel know immediately.

Regards

LORRAINE McLOUGHLIN
Filing Centre Assistant



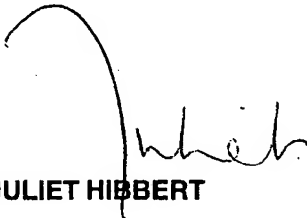
MEMORANDUM

UK IPR DEPARTMENT

To: Phil Brown
cc: Richard Hatch
Employee Number: 10026746
From: Juliet Hibbert
Date: 1st August 2001
DDI: +44 (0) 1252 865101
Subject: INVENTOR'S AWARD STAGE 1
INSTRUCTION FOR PAYMENT

In connection with the Invention Report identified below, please arrange for Richard Hatch to be paid £340 under the Nokia Inventor's Award Scheme.

Please let me know when the inventor receives this award.



JULIET HIBBERT

JJH/pt/115p

INVENTION REPORT DETAILS:

Our ref: NC 33733
Status: PC Decision
Title: SMS/Email Redirection Service
Inventor(s): Richard Hatch

NOKIA IPR DEPARTMENT

Mailing Address: Nokia House, Summit Avenue, Farnborough, Hampshire GU14 0NG, UK

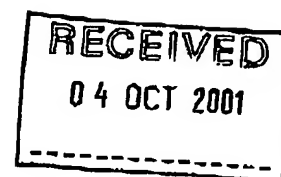
Tel: +44 (0)1252 867244

Fax: +44 (0) 1252 865080

NOKIA

39518

Mr Matthew Read
 Venner, Shipley & Co.,
 20 Little Britain
 London EC1A 7DH



ACKNOWLEDGED: 4/10/01

VENNER SHIPLEY & CO.

02 October 2001

Dear Matthew

**RE: NEW PATENT APPLICATION RELATING TO
 SMS/E-MAIL REDIRECTION SERVICE
 OUR REF: NC 33733
 RATING: 3**

Please draft and file a patent application relating to the above invention as described in the enclosed invention report. Please file this application first in the US by the end of November. Please report the filing to us, by fax, within one working day of filing. Please let us have a copy of the application as filed in electronic format (Word 97 (and Designer 7.1 for drawings)).

The application is to be filed in the name of the following:

Nokia Corporation
 Keilalahdentie 4
 FIN-02150 ESPOO
 Finland

The name, address and nationality of the inventor is:

Richard Hatch
 38 Shakespeare Gardens
 Cove
 Farnborough,
 Hampshire
 GU14 9QT

British

The applicant acquired the rights to the invention from the inventor by virtue of employment and by virtue of an agreement between the inventors' employer Nokia UK Limited and Nokia Corporation.

NOKIA IPR DEPARTMENT
 Nokia House
 Summit Avenue
 Southwood
 Farnborough
 Hampshire
 GU14 0NG
 UK

Tel: +44 (0) 1252 865000
 Fax: +44 (0) 1252 865080

Page 1 of 1
 Nokia UK Limited
 Registered in England No. 2212202
 Registered Office:
 Lancaster House
 Lancaster Way
 Ermine Business Park
 Huntingdon
 Cambs PE29 6YJ

Please send invoices addressed to Nokia UK Limited (for the attention of Juliet Hibbert) to:

Nokia IPR Department
Nokia House
Summit Avenue
Farnborough GU14 0NG.

Please send the draft to me for approval. Hopefully the enclosures describe the invention sufficiently to prepare a first draft but please contact me if you need any further information about the technical aspects of the invention. For drafting purposes, you may of course contact the inventor directly but please keep me informed.

In all other matters (reminders, foreign filing programme requests, office actions etc), please contact me.

Please confirm receipt of these instructions by return facsimile.

Yours sincerely



Dhiren Patel

DP/pt/006p

Enc. Invention report
Brief Summary of the invention
Prior art -

Brief Summary of the invention

This idea is to redirect SMS messages to e-mails when the user knows that he will be out of SMS reach, e.g. when he goes to the US and his GSM does not work there. Whilst in US he can always access his e-mails (maybe even using his WAP browser).

Commercial interests of the applicant

This invention would need to be implemented by a service, service provider or operator on the network side so the patent application needs to include details of this implementation.

The invention extends to the redirection of voice messages for example:

1. Converting to text e.g. using a speech recognition application or something similar and
2. As an audio file.

It could also be used for MMS (Multi Media Services). In its broadest aspect the invention is re-directing anything that is sent to your mobile phone to a specified e-mail account.

The state of the art

None at the moment

BY FACSIMILE
(6 pages)

Mr Stuart Geary
Venner, Shipley & Co.
20 Little Britain
London
EC1A 7DH

13th December 2001

Dear Stuart

**New Patent Application for Nokia on
SMS/EMAIL REDIRECTION**

Your ref:

Our Ref: NC 33733

Thank you for sending me a draft patent specification with your emails of the 30th November and the 7th December 2001. It seems that you never received my email of 30th November 2001 forwarding you the inventor's comments. These I now enclose with this fax (the inventor retracted his comment about spelling when I told him the draft was for filing first in the US!). Also enclosed are some further comments from the inventor on an alternative embodiment which I will explain further below.

Starting from the top, my thoughts on your draft are as follows:

Page 1, line 13

The sentence starting "However, Internet connections" could be seen as anticipating the solution somewhat. Therefore, I would prefer to reformulate the sentence and use it in the context of an advantage of the invention; something along the lines of "Thus, the invention harnesses the fact that Internet connections are readily available".

Page 1, line 21

Statement of invention, see comment on claim 1.

Page 1, line 32, and in other places in the draft specification

Please see the inventor's comments in his attached email on the sentence which refers to "a destination identified in the text message", which might suggest that the text message itself contains an email address. It would not be desirable to have a destination address contained in, and thus read from, the text message for two reasons: 1. it takes up precious text space, 2. the sending party must know the recipients email address.

Statement of Advantage	Please introduce a Statement of Advantage to the effect that even though a user's mobile phone may be out of reach, he can still receive information originally destined for his mobile phone.
Page 3, line 12	Typing error on "network".
Page 3, line 17	I think the word "operator" is missing from after the word "network".
Page 3, line 32	It should of course say SMS gateway 8.
Page 3, line 33	Perhaps more explicit still to say ".... the network operator that text messaging forwarding by e-mail is to be enabled....".
Page 4, line 8	Typing error on "addresses".
Page 4, line 11	Typing error on "parties".
Claim 1	Although the inventor has come up with the idea of redirecting text messages to an e-mail address, I felt the invention could be extended to the redirection of any information which is originally intended to be sent to an out-of-reach mobile phone. Particularly with the advent of 3G and services such as MMS (multi-media services), it will be possible to send all sorts of information to a mobile phone, e.g. images (still and video), audio files, voice messages which could be converted to text or an audio file for redirecting via e-mail, etc.
Other claims	Perhaps you could also include a slightly different worded independent claim simply calling for the assignment of an email address to a mobile phone number and forwarding information to the email address when the mobile phone number is unavailable.

Alternative embodiment

When reading through your draft, it seemed to me that a useful variation on the invention would be automatic activation of the redirection service whenever the user cannot be reached. That is to say, the user does not have to notify the network operator in order to setup/activate the service, but instead the network takes the decision to redirect the message to a specified e-mail address associated with the mobile phone after a given number of unsuccessful attempts to deliver the message to the mobile phone (or after a pre-determined time period has elapsed). In this way, the user does not need to remember to contact the network operator in order to activate the redirection service. Also, if the user is out of reach for longer than he had anticipated the redirection service continues to operate.

I spoke about this possibility with the inventor and he went away and prepared some notes on how such a system could be implemented; these notes are provided in his email dated 11th December 2001, which is attached. Please incorporate this embodiment into the application and add a couple of claims.

I hope that you will find these comments useful (and not picky!) in preparing a second draft. Please forward me the second draft by the early part of next week, as next Wednesday is my last day in the office this year.

Thank you for your assistance in this case.

Yours sincerely

A handwritten signature in black ink, appearing to read 'Dhiren', with a stylized flourish at the end.

Dhiren Patel

Encls.

DP/af/022a

FACSIMILE
(2 pages)

Mr Stuart Geary
Venner, Shipley & Co.
20 Little Britain
London
EC1A 7DH

19th December 2001

Dear Stuart

**New Patent Application for Nokia on
SMS/EMAIL REDIRECTION**
Your Ref: 07 39518
Our Ref: NC 33733

Thank you for the revised draft patent specification which came with your email yesterday. In addition to the inventor's comments in his email dated 18th December 2001 and which is attached, please note the following:

- | | |
|-----------------|--|
| Page 1, line 13 | The sentence starting "The present invention harnesses....". Please move that sentence further down the page to just above the sentence which begins at line 30. |
| Page 1, line 22 | There is a typing error here. |
| Page 2, line 4 | Please insert the word "on" after the word "dependence". |
| Page 1, line 19 | Please replace "identified in a" with "associated with the". |
| Page 4, line 13 | This should say "... the network operator that text message forwarding by email...". |
| Page 4, line 21 | Please replace the word "address" with the word "message". |
| Page 6 | Please add a final paragraph along the following lines:
The email redirection service of the present invention may also be used to forward other communications to an unavailable mobile phone user. For instance, the redirection service can send image files, audio files, voice messages and other forms of information to a specified email address of a user when the user's mobile phone is unreachable. That is to say, using services such as MMS, |

images and other forms of data sent from an originator to a recipient's mobile phone can be transmitted to a given email address associated with the mobile phone number when the mobile phone is out of reach.


Claims 4 and 12

Please add the word "on" after the word "dependence".

With these amendments the application will be in order for filing. I look forward to receiving confirmation of the filing details.

Thank you for your assistance with this application.

Yours sincerely



Dhiren Patel

DP/af/026a

Venner, Shipley & Co.

*Chartered & European Patent Attorneys
Trade Mark Attorneys*

20 Little Britain
London EC1A 7DH

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Facsimile cover sheet

From: Stuart Geary

To: Dhiren Patel

Company: Nokia UK Ltd

Fax no.: 01252 865 080

Date: 24 December 2001

Number of pages in this transmission, including
this sheet:

2

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Mr. Dhiren Patel
Nokia UK Ltd
Nokia IPR Department
Nokia House
Summit Avenue
Farnborough, Hants GU14 0NG

VIA FAX & MAIL

24 December 2001

Dear Dhiren,

New United States Patent Application
SMS/EMAIL REDIRECTION SERVICE
Nokia Corporation
Your ref: NC 33733 Our ref: 07 39518

This is to confirm that the above-identified patent application has now been filed at the USPTO. Full filing details will follow in due course.

Yours sincerely,



STUART GEARY
VENNER, SHIPLEY & CO.

Alan Venner MIMA
John Woodward CFA RPA
Matthew Read BSc CFA RPA
Chris Weatherly MIMA
Timothy Jump BSc CFA RPA
Seamus Geary MSc CFA RPA
Stephen Killin BSc CFA RPA

Ian Grey MSc MIMA CFA RPA
Edmund Harrison MSc
Jan Walski BSc CFA RPA
Pawel Piotrowski BSc RPA
Sian Hughes BSc MSc RPA
Paul Kelly MIMA
Catherine Cooley BSc RPA
Craig Thomson BSc MSc